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SMITHKLINE BEECHAM CORPORATION  
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In re Application of: COATES, William, John, et al. :  
U.S. Application No.: 09/600,984 :  
PCT No.: PCT/EP99/00333 : DECISION ON PETITION  
International Filing Date: 21 January 1999 : UNDER 37 CFR 1.47(a)  
Priority Date: 26 January 1998 :  
Attorney's Docket No.: P31957 :  
For: QUINOLINE DERIVATIVES AS :  
ANTIBACTERIALS :

This decision is issued in response to the "Petition Under Rule 37 CFR 1.47(a)" filed on 15 February 2001. Deposit Account No. 19-2570 will be charged the required petition fee.

### **BACKGROUND**

On 25 July 1999, applicants filed international application PCT/EP99/00333 which claimed a priority date of 26 January 1998 and which designated the United States. On 29 July 1999, a copy of the international application was communicated to the United States Patent And Trademark Office ("USPTO") by the International Bureau ("IB").

On 29 July 1999, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was extended to expire thirty months from the priority date, i.e., 26 July 2000.

On 25 July 2000, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 15 August 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing the declaration later than was required.

On 15 February 2001, applicants filed a response to the Notification Of Missing Requirements. The response included an authorization to charge Deposit Account No. 19-2570 the \$130 surcharge and the \$1,890 fee for a five-month extension of time, declarations executed by seven of the eight inventors, and the petition considered herein, which seeks acceptance of the application without the signature of the remaining inventor, Ian Keith HATTON.

### DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration by the other inventors on behalf of themselves and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort. As discussed below, applicants here have failed to satisfy items (3) and (4).

Regarding the petition fee, applicants have authorized a charge to Deposit Account No. 19-2570 for the required fee. Item (1) is therefore satisfied.

The petition specifically sets forth the last known address of the nonsigning inventor, Ian Hatton. Accordingly, item (2) is satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Procedure ("MPEP") states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Applicants here have filed declarations executed by seven of the eight inventors and containing an unexecuted signature block for the non-signing inventor. Pursuant to the MPEP, the complete declarations executed by the signing inventors and containing the unsigned signature block for the nonsigning inventor may be accepted as having been signed by the inventors on their own behalf and on behalf of the nonsigning inventor. Item (3) is therefore satisfied.

Regarding item (4), applicants assert that Dr. Hatton has refused to execute the application.

Before a refusal to execute the application can be claimed, MPEP § 409.03(d) requires that the nonsigning inventor be provided with a copy of the complete application. The MPEP also requires "a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made." Here, the petition itself consists of a statement of the nonsigning inventor's last known address and a series of exhibits that consists of the correspondence between the nonsigning inventors and Jill Valentine (identified in the petition as a "Smithkline Beecham European agent"), Sarah Doe (identified in her correspondence as a Smithkline Beecham "Corporate Intellectual Property Administrator"), and Fiona Reardon (identified in her correspondence as a Smithkline Beecham "Senior I.P. Administrator"), and Dileen Mack (identified in her correspondence as a Smithkline Beecham "C.I. P. Administrator").

The correspondence attached to the petition implies that Dr. Hatton has been provided with a copy of the complete international application, as required (see Exhibit L and Exhibit M), and it discusses the reluctance of Dr. Hatton to execute the application documents. However, the petition does not include the required statement from a person with first-hand knowledge of the correspondence and the inventor's refusal to sign (i.e., Ms. Valentine and/or Ms. Doe, Ms. Reardon, and Ms. Mack). Without such a firsthand statement clarifying and supporting the statements contained in the correspondence, the correspondence itself is insufficient to justify the conclusion that the nonsigning inventor has been presented with a copy of the complete application papers and has refused to execute the application. Accordingly, on the present record, item (4) is not satisfied.

Based on the foregoing, applicants have failed to satisfy all the requirements for a grantable petition under 37 CFR 1.47(a). Accordingly, the petition must be dismissed.


### CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.


If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and should include the required statement from a person with first-hand knowledge of the correspondence with the nonsigning inventor and the inventor's refusal to sign, as discussed above and in the form required by MPEP § 409.03(d). No additional petition fee is required.

Failure to file a timely response will result in abandonment of the application.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the International Division, Legal Staff.

  
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